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REMARKS

Claims 1 – 27 are pending in the present Application. Claims 1, 15, and 24 have been amended, Claims 14 and 17 – 20 have been cancelled, and Claims 28 – 32 have been added, leaving Claims 1 – 13, 15 and 21 – 32 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Amended Claims

Claims 1 and 24 have been amended to better define the invention. Support for the amendment can be found in the Claim 14 as originally filed.

Claim 15 has been amended to correct for the proper dependency.

New Claims

Claims 28 – 32 have been newly added. Support for these claims can be found in at least Claims 16 – 20 as originally filed

Claim Rejections Under 35 U.S.C. § 102

Claims 1 – 4, 9, 12 – 15, 17 – 20 24, 26 and 27 stand rejected under 35 U.S.C. § 102(a) and/or § 102(e), as allegedly being anticipated by U.S. Patent No. 6,800,804 to Igarashi et al. (Igarashi) Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Barent Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Claim 1 as presently amended is directed and claims an article comprising an electrical component; and an electrically insulating layer disposed upon the electrical component, wherein the electrically insulating layer comprises a thermosetting polymer and a nanosized filler; wherein the nanosized filler consists essentially of particles having the formula (II)



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where MeO is any divalent ferrite forming metal oxide or a combination comprising two or more divalent metal oxides, and "x" is less than 50 mole percent.

Igarashi teaches an encapsulating resin layer that contains epoxy resin, phenolic resin, curing accelerator and conductive or magnetic particles that are coated with an insulating organic material. (see Abstract) Igarashi teaches that the insulating organic material is expressed by a general formula MFe_2O_3 or $MO.nFe_2O_3$, wherein n is a positive number. (See Col. 4, lines 25 – 26) The claimed invention in contrast is directed to nanosized fillers consisting essentially of particles having the formula (II)



where MeO is any divalent ferrite forming metal oxide or a combination comprising two or more divalent metal oxides, and "x" is less than 50 mole percent.

Since Igarashi teaches conductive or magnetic particles that are coated with the inorganic material, while the claimed invention is directed to the nanosized inorganic fillers alone Igarashi cannot anticipate the claimed invention. Applicants respectfully request a withdrawal of the § 102 rejection over Igarashi and an allowance of the claims.

Claims 1, 3 – 13, 17 – 25 and 27 stand rejected under 35 U.S.C. § 102(a) and/or § 102(e), as allegedly being anticipated by U.S. Patent Application No. 2003/0113461 to Ahmed et al. (Ahmed) Applicants respectfully traverse this rejection.

Ahmed teaches a rubber composition comprising an inorganic extending filler and an amorphous SiO_2 reinforcing filler. (see Abstract) The inorganic extending filler is aluminum trihydrate. (See Page 3, paragraph [0035]) Since Ahmed does not teach fillers that consist essentially of particles having the formula (II)



Ahmed does not teach all elements of the claimed invention. Applicants respectfully request a withdrawal of the § 102 rejection over Ahmed and an allowance of the claims.

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Claim Rejections Under 35 U.S.C. § 102 over Nakashima, Silver, Kodama and JP 06028929A

Claims 1 – 4, 9 – 13, 17 – 20 and 24 - 27 stand rejected under 35 U.S.C. § 102(a), (b) and/or (e), as allegedly being anticipated by U.S. Patent No. 6,562,465 to Nakashima et al. (Nakashima)

Claims 1 – 4, 9, 13, and 24 are rejected under 35 U.S.C. § 102 (b), as allegedly being anticipated by U.S. Patent No. 4,317,001 to Silver et al. (Silver)

Claims 1, 3 – 13, 17 – 20 and 24 - 27 are rejected under 35 U.S.C. § 102 (b), as allegedly being anticipated by U.S. Patent No. 4,025,485 to Kodama et al. (Kodama)

Claims 1- 3, 12 – 13, 24 and 27 are rejected under 35 U.S.C. § 102 (b), as allegedly being anticipated by JP 06028929A.

Neither Nakashima, Silver, Kodama nor JP 06028929A teach fillers that consist essentially of particles having the formula (II)



Nakashima, Silver, Kodama or JP 06028929A therefore do not teach all elements of the claimed invention. Applicants respectfully request a withdrawal of the § 102 rejections over Nakashima, Silver, Kodama and JP 06028929A and an allowance of the claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 16 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over [?] in view of U.S. Patent No. 6,800,804 to Igarashi et al. (Igarashi) Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing

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a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

In this first instance, it must be pointed out that Claim 16 depends from Claim 1. As noted above, Igarashi does not teach all elements of Claim 1. Additionally since Igarashi does not teach all elements of the claimed invention, one of ordinary skill in the art would not be motivated to modify Igarashi to arrive at the claimed invention. Thus there is no motivation to modify Igarashi to arrive at the claimed invention. For these reasons the Examiner has not made a *prima facie* case of obviousness over Igarashi. Applicants respectfully request a withdrawal of the rejection and an allowance of Claim 16.

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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0868.

Respectfully submitted,

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